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PATENT  
Attorney Docket No.: 021911-000510US  
Client Ref. No.: OBM30Div1

TOWNSEND and TOWNSEND and CREW LLP

By: *Carmela Skotton*

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:

Miles W. Carroll, et al.

Application No.: 10/774,176

Filed: February 6, 2004

For: POLYPEPTIDE

Customer No.: 20350

Confirmation No. 7186

Examiner: Marianne DiBrino

Technology Center/Art Unit: 1644

REPLY TO NOTICE/COMMUNICATION  
MAILED May 31, 2006

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This is in reply to the Office Communication mailed May 31, 2006, which set June 31, 2006 as the initial deadline for response. This Reply is believed to be timely filed, and no fees are believed to be due.

Further to the Reply to Restriction filed March 22, 2006, and in response to the position set forth in the Communication mailed May 31, 2006, Applicants respectfully request reconsideration in light of the following remarks, which include those in the previous Reply. Applicants intend this to help expedite prosecution by providing a single document with Applicants' remarks in response to Restriction.

Interview Summary

Applicants thank Examiner DiBrino for the courtesy of a brief telephonic discussion with the undersigned on June 5, 2006 to clarify the position set forth in the Communication. In response to a proffered election of “poxvirus vector”, Examiner DiBrino indicated that election of a vector “species” for each of claimed vector was needed to facilitate search requirements. She also indicated that the search would be extended to additional species of vectors as provided under standard species election practice.

Remarks

Claims 1-33 are pending and have been restricted. The restriction alleges the presence of two Groups of claims, with Group I being claims 1-21 and 26-33 and Group II being claims 22-25.

Applicants acknowledge and thank the Examiner for recognizing that asserted Groups I and II are related as product and process of use, respectively. Applicants respectfully however, traverse because the asserted basis of the restriction is misplaced. The statement of restriction alleges that

“the process for using the product as claimed can be practiced with another materially different product such as a non-viral vector, naked DNA, or transfected dendritic cells.” (see page 3 of the Restriction Requirement)

Contrary to this allegation is the fact that the Group II claims do not literally encompass the “materially different products” recited in the above statement. Instead, claims 22-25 are directed to the administering of pairs of vectors as defined in claims 16, 17, 20, and 21, respectively. So how can methods for using those pairs of vectors be practiced with the “materially different” products listed above? Because this is not possible, Applicants believe that Group II is directed to the use of the products of Group I. Accordingly, no restriction is proper between the Groups, and the restriction may be properly withdrawn.

In the event that the Restriction Requirement is maintained despite the above traversal, Applicants elect Group I, claims 1-21 and 26-33 with traverse for the reasons provided above.

Applicants remind the Examiner of rejoinder practice as set forth at MPEP 812.04 upon an indication of the allowability of elected Group I. That practice would require the rejoinder of Group II to Group I.

The restriction further requires Applicants to “elect a single disclosed species”, apparently by sequence, if Group I is elected. Applicants respectfully submit that a requirement for an election of species from a genus of products must be based upon 37 C.F.R. § 1.141(a) and 1.146, both of which expressly recognize that “a reasonable number” of species may be claimed along with allowable generic claims within a single application. Applicants point out that there has been no demonstration that “more than a reasonable number of species” is encompassed by the pending claims.

Applicants therefore traverse this requirement because no more than a reasonable number of species is presented in the claims of Group I. Moreover, and as set forth at 37 C.F.R. § 1.146, requiring election of a species is discretionary and results in a restriction *only* “if no claim to the genus is found to be allowable.” Thus Applicants respectfully submit that the requirement for an election of species is for purposes of facilitating search and examination. If no prior art is found to anticipate or render obvious the elected species, Applicants respectfully submit that the search of the claims should be extended to the next species to allow for consideration of the generic claim encompassing multiple species.

Based on the above, Applicants respectfully submit that the requirement for an election of species is misplaced and should be modified or withdrawn.

In the event that the requirement for election of species is maintained, Applicants elect Group I, with traverse as provided above, and the species of “SEQ ID NO:5” for the 5T4 antigen in claims 1-21 and 26-33, with traverse. In claims 16-21 and 26-33, the same sequence is elected for the 5T4 antigen in each of the two vectors.


With respect to the requirement for the election of a vector "species", Applicants respectfully traverse and request reconsideration because the species of "poxvirus vector" for both the vector of claims 1-15 and as each of the two vectors in claims 16-21 and 26-33 would also serve the function of facilitating search and examination while being responsive to the Restriction Requirement. Specifically, a "poxvirus vector" is recited in claims 2, 16, 17, 26-33. Additionally, the MVA vectors of claims 3 and 18 as well as the entomopox vectors of claims 5, 20, and 21 are all poxvirus vectors.

In the event that the requirement is maintained, Applicants elect "MVA" as the poxvirus vector in claims 1-15 and as each of the two vectors in claims 16-21 and 26-33.

Applicants respectfully submit that claims 1-4, 9-14, 16-19, and 27-33 read on the elected species, with claims 1, 2, 4, 9-14, 16-19, and 27-33 being generic to the elected species.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 858-350-6100.

Respectfully submitted,

  
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